

REMARKS

Claims 1-3 and 7-14 are now currently pending in the present application. Claims 3 and 14 have been withdrawn from consideration. Claims 1, 2 and 7-13 stand rejected. Claim 1 has been amended, support for which can be found in Figure 2 and Figure 3.

It is respectfully requested that the present Reply be entered into the Official File in view of the fact that the Reply automatically places the application in condition for allowance. Thus, the present Reply is believed to be in proper form for placing the application in condition for allowance.

In the alternative, if the Examiner maintains the rejections of the present application, it is respectfully requested that the present Reply be entered for purposes of an Appeal. The Reply reduces the issues on appeal by overcoming one or more of the rejections under 35 U.S.C. § 102(e)/35 U.S.C. § 103(a). Thus, the issues on appeal would be reduced.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1, 2 and 7-13 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claim 1 has been amended to specify that the method is for “identifying heterologous DNA and the mRNA transcribed therefrom”.

It is clear from the specification, as a whole, that the method can isolate and identify both mRNA and DNA from which it is transcribed. In particular, Figure 2 and Example 6 demonstrate that the method is used to analyze mRNA as well as DNA.

The Examiner has stated that it is not clear if step (ii) relates to a DNA library of member derived from the library.

Applicants respectfully submit that it is clear from the context of the claims that each cell contains a different DNA molecule and that said DNA could be a member of a DNA library. However, in an effort to expedite prosecution of the present application, the phrase “said DNA sequence being a member of a DNA library” has been deleted from claim 1.

Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

Rejections Under 35 U.S.C. § 102(e)/35 U.S.C. § 103(a)

Claims 1, 2 and 7-13 stand rejected under 35 U.S.C. 102(e) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over US 6994993 to Qin et al. (hereinafter “Qin”).

Claims 1, 2 and 7-13 stand rejected under 35 U.S.C. 102(e) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over US 6969449 to Maher et al. (hereinafter “Maher”).

Applicants respectfully traverse each of the outstanding rejections.

As a preliminary matter, Applicants respectfully submit that the Examiner’s continued maintenance of the outstanding rejections appears to be based on a misunderstanding of the present invention. The “substrate” as discussed in claim 1, step (i), is in fact an “assembly” as previously discussed. In Applicants’ response dated August 13, 2007, it was explained that:

None of the cited documents describe the analysis of multiple different DNA molecules as part of the same assembly. Each of these documents describes the analysis of cells (either singly or multiple cells) each containing the same heterologous DNA expressing a single defined ion channel.

Moreover, one of the key benefits of the present invention is the ability to isolate the mRNA from the cell while the cell is still positioned on the substrate. This feature is not disclosed in either Qin or Maher. Claim 1 has been amended to include this feature—"showing a change in its electrophysiology as measured in step (iii), wherein the mRNA is isolated without removing the cell from the substrate."

Accordingly, it is apparent that the present claims are patentably distinct from the disclosures of Qin and Maher. Reconsideration and withdrawal of the outstanding rejections is respectfully requested.

In view of the foregoing, Applicants believe the pending application is in condition for allowance. A Notice of Allowance is earnestly solicited.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Monique T. Cole, Reg. No. 60,154 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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